

Attorney Docket No. LUKP:123US
U.S. Patent Application No. 10/711,823
Reply to Office Action of April 19, 2006
Date: July 14 2006

Remarks

The New Matter Objection under § 35 U.S.C. § 132 (a)

The Examiner objected under 35 U.S.C. § 132 (a) to the amendment to the specification entered in the Reply dated February 1, 2006 as introducing new matter into the disclosure. The Examiner stated two grounds for this objection – with respect to the amended drawing of the guide shoes and with respect to the structural limitations of the term “jib”.

With regard to the objection to the amended drawing of the guide shoes, Applicants respectfully traverse this objection and request reconsideration. As mentioned in the previous Reply, the drawing of Figure 2 was amended to add the three additional guide shoe parts **38** that were claimed in Claim 8. The guide shoe parts were originally described in paragraph 0013 of the original specification as “...arranged at the ends of jibs **12** to **15** on the contact surfaces toward the gearshift rails, which guide shoe parts are made of plastic and can be clipped on. Such a guide shoe part is illustrated in the form of a diagram in Figure 2 and is labeled **38**.⁷” As noted in the previous Reply, only one guide shoe part on jib **14** was depicted in Figure 2 of the original drawings and it was not labeled. (See Appendix I showing original drawing of Figure 2.) In amended Figure 2, shown in Appendix II, the remaining three guide shoe parts were depicted on the ends of jibs **12**, **13**, and **15** as described in paragraph 0013 of the original specification and were labeled with reference no. **38**.

MPEP § 2163.06 states that “information contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter.” Applicants respectfully submit that the description of the guide shoe parts as “arranged at the ends of jibs **12** to **15**” accurately describes the position of the guide shoe parts as shown in amended Figure 2. The jibs themselves are labeled and described in paragraph 0013 of the original specification as “... comprises two upper jibs **12**, **13** as well as two lower jibs **14**, **15** that preferably protrude from attachment part **11** into the gear and that between themselves guide and support the packet of gearshift rails.” The jibs are seen as protruding from attachment part **11** in original Figure 2 and additionally, original Figure 2 also shows one guide shoe part. Original Claim 8 also describes guide shoe parts at the ends of the

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jibs. Therefore, because all of the guide shoe parts were described as to location in the original specification and one guide shoe part was shown in the described position at the end of a jib, Applicants respectfully submit the guide shoe parts were described in the original application as filed. Consequently, the depiction of guide shoe parts at the end of each jib in amended Figure 2 does not introduce new matter. Applicants respectfully request reconsideration and the withdrawal of the new matter objection to amended Figure 2.

With regard to the new matter objection to the term jib, the Examiner objected to the amendment to the specification that provided a definition of the term “jib” as introducing new matter. Applicants have amended paragraph 0013 to remove the definition of the term jib that was added in the previous Reply. Applicants respectfully request reconsideration and removal of the new matter objection to the definition of the term “jib.”

Amendments to Claims 1-9

Applicants have amended Claims 1 and 3-9 and cancelled Claim 2. Claim 1 has been amended to more particularly claim the bearing arrangement by describing it as being formed by protruding rods arranged to support the gearshift rails. Support for the amendment to Claim 1 can be found in paragraph 0013 describing the bearing arrangement for the gearshift rails as preferably comprising two upper and two lower jibs that preferably protrude from attachment part 11 into the gear and that guide and support the gearshift rails. In addition, the protruding rods can be seen in Figures 2 (rods 12-15) and 3 (rods 32 and 33) of the specification. In addition, Claim 1 has been amended to delete the guide function of the protruding rods. Based on the cancellation of Claim 2, Claims 3-9 have been amended to correctly depend from amended Claim 1 and to properly claim the “protruding rods” element of amended Claim 1. Applicants respectfully request entrance of the amendments of Claims 1, 3-9 and the cancellation of Claim 2.

In addition, Claim 7 has been amended to more particularly claim the embodiment in which each member of an upper pair of protruding rods and a lower pair of protruding rods, respectively, are symmetrical in relation with the selector shaft.

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Amendment to the Drawings

The Examiner objected to the drawings under 37 CFR §1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Examiner stated that the bearing arrangement consisting of two symmetric jibs, as claimed in Claims 6 and 7 and the guide rail parts at their ends resting against the gearshift rails, as claimed in Claim 8 must be shown.

Regarding the guide shoe parts, Applicants have amended Figure 3 to show guide shoe parts **38** on protruding rods **32** and **33** and resting against the gearshift rails. Applicants respectfully point out that both original Figure 3 and amended Figure 3 show the packet of gearshift rails **26-28** supported by protruding rods **32** and **33** as is claimed in Claim 6. Applicants respectfully request reconsideration and removal of the objection to the drawings as regards Claim 8.

Applicants respectfully traverse the Examiner's objection that the drawings do not show two symmetric jibs as claimed in Claims 6 and 7. First, Applicants respectfully point out that Claim 6 does not claim two symmetric jibs but, before amendment, only claimed two jibs. (Claim 6 has been amended to now claim two protruding rods.) Applicants submit that Figure 3 depicts the two protruding rods **32** and **33** claimed in Claim 6 that are also described in paragraphs 0015 and 0016. Applicants respectfully request reconsideration and removal of the objection to the drawings as regards Claim 6.

Applicants respectfully submit that Figure 2, both as originally filed and as amended, depicts the embodiment claimed in Claim 7 in which two protruding rods at a time are symmetrically opposite each other with respect to the selector shaft. Applicants respectfully point out that the upper pair of protruding rods **12** and **13** and lower pair of protruding rods **14** and **15** are symmetrically opposite from each other as related to selector shaft **2** as each member of both the upper and lower pairs are the same distance from the selector shaft and each plane formed together by each of the upper and lower pairs are both parallel to the upper and lower sides of the attachment part **11**. This configuration per force makes the two pairs symmetrical as

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related to the selector shaft. Applicants respectfully request reconsideration and removal of the objection to the drawings as regards Claim 7.

The 35 U.S.C. § 112 Rejections of Claims 1-9

The Examiner rejected Claims 1-9 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Specifically, the Examiner states that the specification fails to make clear how the jibs serve the purpose of guiding the rails as the rails appear to slide across the lower jibs with no reduction of the degree of freedom outside the support aspect. In addition the Examiner states that it is unknown what the guide shoe parts are with respect to the rails. Applicants have cancelled Claim 2 thereby rendering the rejection of that claim moot. Applicants respectfully traverse the rejection of Claims 1, and 3-9 under §112, first paragraph and request reconsideration. In addition, Applicants respectfully point out that Claim 1 has been amended to delete the limitation “guiding” thereby rendering the rejection based on lack of enablement for “guiding” moot.

Regarding the Examiner’s statement that it is unknown what the guide shoe parts are with respect to the rails as claimed in Claim 8, Applicants respectfully point to paragraph 0013, discussed above, describing the guide shoe parts as placed at the ends of the protruding rods. As noted above, Applicants respectfully submit that the depiction of the guide shoe parts on the ends of protruding rods 12-15 is not new matter having been explained in paragraph 0013 as originally filed. In addition, Applicants respectfully submit that, given the disclosure of guide shoe parts of the ends of two pairs of protruding rods, it would be obvious to those of skill in the art to place guide shoe parts on the ends of a single pair of protruding rods as seen in amended Figure 3.

Additionally, Applicants acknowledge the Examiner’s remarks that the protruding rods serve only to create friction and wear. Applicants respectfully point out that as the protruding rods create friction and wear they must be contacting the gearshift rails and thus supporting them. Applicants respectfully refer to paragraph 0003 of the specification describing the problem of larger or longer gearshift rails subjected to a softly bending bearing. In addition,

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Applicants point to paragraph 0006 describing the invention as providing an additional bearing or bearing arrangement in which the gearshift rails can be supported in the middle. This is particularly described in paragraph 0016 of the specification describing that the gearshift rails are supported by jibs (now protruding rods) **32, 33**. Therefore, as indirectly acknowledged by the Examiner and described by the specification, the protruding rods do provide the additional support to the gearshift rails which is the described purpose of the invention. In addition, Applicants respectfully point out that Claims 1 and 3-9 do not claim the protruding rods as the sole support of the gearshift rails.

The Examiner rejected Claims 1-9 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

First, Applicants have amended Claim 1 to remove the element “disengaging shaped element” and replaced it with the limitation “disengaging element” to more particularly claim the function of that component(s) of the shift finger. Regarding the Examiner’s statement that it is unclear what the single selector shaft refers to, Applicant points to paragraph 0012 describing a “central selector shaft **2**.” Applicants respectfully submit that that if a claim element is identified with the same nomenclature in both the specification and claim, is described in the specification in terms of its position within the device (“positioned in bearing parts **19**”), other components are described that are positioned on that element (“...the shift finger **3** and the disengaging shaped elements **4, 4** on selector shaft **2**.”), is depicted in two different Figures (1 and 2) as the only component of its type, and is the only component labeled with reference no. 2 a person of ordinary skill in the art would recognize what the term single selector shaft refers to. Applicant respectfully requests reconsideration and removal of the rejection of Claim 1 under §112, second paragraph.

The Examiner rejected Claims 2-9 under §112, second paragraph, stating that the term “jib” is unclear and not sufficiently defined. Applicants have cancelled Claim 2 rendering the rejection of that claim moot. Applicant have amended Claim 1 and Claims 3-9 to substitute the term jib with the term protruding rod which is clearly seen in Figures 1-3 and described in

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paragraph 0013. Applicant(s) respectfully request reconsideration and removal of this rejection of Claims 3-9 under §112, second paragraph.

The Examiner rejected Claims 6 and 7 under §112, second paragraph stating it is unclear what is the structure of the two symmetric jibs. Applicant respectfully submits that Claim 6 has been amended to claim two protruding rods and does not include, and never did include, the limitation of symmetric jibs or symmetric protruding rods. Applicants respectfully request reconsideration and removal of the rejection of Claim 6 under §112, second paragraph.

Amended Claim 7 claims the device in which two pairs of protruding rods are symmetric with the selector shaft. Applicants respectfully submit that the correlation of the single selector shaft with the symmetry of two pairs of protruding rods, distinctly claims the subject invention in that symmetry around a selector shaft would necessarily mean symmetry on either side of the selector shaft. The selector shaft as depicted is a shaft having a length considerably greater than its width and possesses a radial symmetry along its length. In order to be symmetrically opposite with each other with respect to the selector shaft, a person of ordinary skill in the art would recognize that the protruding rods would have to be on opposite sides of the length of the selector shaft. This would mean that the members of the two pairs of upper and two lower protruding rods are each symmetrical with each other in relation to the selector shaft. Applicants respectfully submit that the structure of Claim 7 is distinctly described and claimed and requests reconsideration and removal of the rejection of Claim 7 under §112, second paragraph.

The § 102 (b) Rejections of Claims 1-9

The Examiner rejected Claims 1-9 under 35 U.S.C. §102 (b) as anticipated by U.S. Patent No. 5,816,101 to Weston (“Weston” or “the Weston patent”). Applicants have cancelled Claim 2 rendering the rejection of that claim moot. Applicants respectfully traverse the rejection of Claims 1 and 3-9 and request reconsideration.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP §

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2131. (Emphasis added.) In addition, “Every element of the claimed invention must be literally present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicants respectfully submit that the Weston patent fails as a reference under §102 (b) because it fails to disclose each element of amended Claim 1 as arranged in that claim. The Examiner points out that selector shafts 112-117 are each a single shaft. First, while Weston discloses a plurality of single selector shafts, as acknowledged by the Examiner, Claim 1 claims only one selector shaft in the invention. See line 2 of Claim 1 claiming a single selector shaft. Therefore, for this first reason, Weston fails to anticipate Claim 1. Second, Claim 1 claims a single selector shaft in a single housing. See line 2 of Claim 1 claiming a housing. Weston fails to disclose a device which has only a single selector shaft within one housing. Therefore, for this second reason, Weston fails to anticipate Claim 1 as it fails to disclose a device with one single selector shaft in one housing. Applicants respectfully request reconsideration and allowance of Claim 1.

Claims 3-9 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Weston patent fails to anticipate all the elements of Claim 1, it also fails to anticipate Claims 3-9. Applicants respectfully request the removal of the rejections of Claims 3-9 and allowance of those claims.

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Conclusion

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



C. Richard Lohrman
Registration No. 46,878
Attorney for Applicant
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221
Phone: (716) 626-1564
Fax: (716) 626-0366

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Amendments to the Drawings

The attached sheet of drawings includes changes to Sheet 2. This sheet, which includes Fig. 3, replaces the original sheet including Fig. 3. In Figure 3, previously omitted element guide shoe parts **38** has been added.

Attachment: Replacement Sheet[s]

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Appendix I

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Appendix II



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Appendix III

